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101

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/233,177	01/19/99	MALLO	P S-4508

000466 HM22/0728  
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EXAMINER
BERMAN, A

ART UNIT	PAPER NUMBER
1619	12

DATE MAILED: 07/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. 09/233,177	Applicant(s) MALLO ET AL.	
	Examiner Alysia Berman	Art Unit 1619	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2000.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- |   |  |
|---|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9</u> . | 20) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

1. Receipt is acknowledged of the information disclosure statement filed 01 December 1999 and the amendment filed 15 May 2000. Claims 1-20 and 22-24 have been canceled. Claims 25-49 have been added and are pending.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 25-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 25 recites "the strongly acidic function of the monomer containing it being a sulfonic acid function or a phosphonic acid function" but further recites "the monomer being 2-methyl-2-[(1-oxo-2-propenyl)amino]-1-propanesulfonic acid" which renders the claims indefinite. The strongly acidic monomer is first identified as being either a sulfonic acid or a phosphonic acid. However, it then appears that it is limited only to the sulfonic acid function. It is unclear if applicants<sup>¶</sup> intend to claim only the sulfonic acid functional monomer or if applicants<sup>¶</sup> intend to claim either a sulfonic acid or phosphonic acid functional monomer. Clarification is requested.

5. Claim 25 recites a Markush group of neutral monomers that ends with "and 2,3-dihydroxypropyl methacrylate, and an ethoxylated derivative, ..., of each of these esters" which renders the claim indefinite. It is unclear if the ethoxylated derivatives are part of the Markush

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group or are additional components of the composition. It is suggested that "and" at line 20 be deleted and a comma be inserted therefor.

6. Claim 42 is indefinite because it appears to claim a Markush group but is not written using proper Markush language. The proper language for a Markush group is, for example, "selected from the group consisting of A, B and C" or "wherein ... is A, B or C." Clarification is requested.

7. Claim 43 is indefinite because it recites optional additives that appear to be required. Is applicants' intent to require that the optional additives are emulsified with the monomers or are the monomers emulsified, optionally with the additives? Clarification is requested.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102((e), f) or (g) prior art under 35 U.S.C. 103(a).

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10. Claims 25-31 and 35-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,185,395 ('395).

This rejection is maintained for reasons of record.

11. Claims 25-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 503853 ('853) in view of US '395.

This rejection is maintained for reasons of record.

12. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP '853 in view of US '395 as applied to claims 25-48 above, and further in view of US 5,472,698 ('698).

EP '853 and US '395 teach all the limitations of the claims as stated above. They do not teach the addition of an n-acyl amino acid.

US '698 discloses a cosmetic emulsion composition comprising n-acetyl-L-serine (abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of the combination of EP '853 and US '395 and add n-acetyl-L-serine as taught by US '698 with the reasonable expectation of producing a cosmetic emulsion composition. The motivation to do so flows logically from the art-recognized desire of a skin treatment composition that enhances lipid production.

Presently no claim is allowed.

#### ***Response to Arguments***

13. Applicant's arguments filed 15 May 2000 have been fully considered but they are not persuasive.

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14. Applicant argues that US '395 is neither branched nor crosslinked and, therefore, cannot be used as a thickener. In any polymerization reaction it is reasonable to expect some branching and crosslinking to occur. Therefore, absent evidence to the contrary, it is reasonable to expect that the copolymer of US '395 would contain some branching and/or crosslinking and provide thickening properties.

15. Applicant argues that there is no motivation to combine EP '853 with US '395. US '395 teaches that carboxylic acid monomers and neutral monomers may be used in the polymerization reaction with AMPS. Therefore, it is reasonable to expect that substitution of acrylamide in EP '853 with one of the monomers taught in US '395 would result in a suitable copolymer. Both references are directed to the same field of endeavor, producing inverse emulsions, and are addressing the same problem, stability. The final intended use of the inverse emulsion, whether for cosmetics or drilling muds, is not given patentable weight.

### *Conclusion*

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703/308-4638. The examiner can normally be reached on 8:00-4:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703/308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703/305-3704 for regular communications and 703/305-3704 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-1234.

  
Alysia Berman  
Patent Examiner  
July 20, 2000

  
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SUPERVISORY PATENT EXAMINER  
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